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10/729,233	12/05/2003	Roger Thomas	P-US-PR 1110	9213

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Michael P. Leary  
Group Patent Counsel  
Black & Decker Corporation  
701 E. Joppa Rd., Mail Stop TW199  
Towson, MD 21286

EXAMINER

SELF, SHELLEY M

ART UNIT PAPER NUMBER

3725

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/729,233

Applicant(s)

THOMAS ET AL.

Examiner

Shelley Self

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/5/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 10 and 12-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 13 of copending Application No. 10/729234. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the presently presented application are merely a broader version of the independent claim of co-pending application, 10/729234 and therefore, the broader claims can be anticipated by the narrower claims. Accordingly, the claims of presently presented application are not distinct from that of the co-pending application, 10/729234.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show *plastic cap...is used to seal up the other aperture* (pg. 4, line 26) and *a spring biases the curved pivotal flap to the lower position indicated by reference letter Q* (pg. 7, lines 10, 11) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *motor, airflow generator*, (clm. 1) *exhaust aperture* (clm. 5), the *first and second exhaust apertures* (clm. 8), the *flap is further movable to a third position wherein the flap closes the second exhaust aperture* (clm. 8) the *resiliently biased flap* (clm. 12, 13) and a *spring* (clms 14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: *T*.

All of the drawings should be reviewed to ensure proper annotation of elements and references to such within the written disclosure.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) and/or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be

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canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

- Page 4, line 31, "sidewaysly" is not understood
- Page 7, line 17, "...*internal structure of the body 2 to of the planer...*" is not understood
- Page 7 line 18, "...*pivotal flap is its downward position...*" is not understood

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 5 and 7-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not

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described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regard to claim 2, neither the specification nor the drawings provide support for a “...*third direction of the nozzle airflow and the first direction of the debris intersect at an acute angle*”

With regard to claim 5, neither the specification nor the drawings provide support for an exhaust aperture as set forth in the claim. In fact, the specification makes no reference to the term, “exhaust aperture”. Therefore, a clear understanding of the exhaust aperture cannot be determined from the written description. Further the specification defines an “expulsion aperture”, it is not clear as to whether the exhaust aperture and the expulsion aperture terms are being used interchangeably or if the two are separate elements of the claimed invention.

Clarification is required.

Regarding claims 8 and 9, the specification fails to describe in detail the arrangement of a first and second exhaust aperture.

Accordingly, the disclosure appears to be inadequate.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 5, 7-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 5, the claim is particularly confusing. For example, the claim defines an exhaust aperture, in line 1 and line 2 states, “the aperture”,

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however it is not clear as to whether, "the aperture" refers to the exhaust aperture previously mentioned in claim 5 or if it refers to the expulsion aperture of the parent claim 1. Clarification is required.

"There are insufficient antecedent bases for the following:

*"the aperture"* ( clm. 5)

*"the flap"* (clms. 7-10, 12 & 13)

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Zaiser et al.

(4,601,104). Zaiser discloses a planer comprising: a shoe (fig. 1), the shoe defining an aperture (Examiner notes, the opening where the periphery of the cutting drum 4 protrudes): a body (1) mounted on the shoe; the body including a wall and the wall defining a recess (fig. 1, 2) and an expulsion aperture (col. 2, lines 47-51); a cutting drum (4) rotatably mounted within the recess (fig. 1), the drum having a periphery and a portion of the periphery of the cutting drum projects through the aperture in the shoe; a motor mounted (2) within the body to rotatingly drive the cutting drum; a cutting blade (4) mounted on the periphery of the drum and adapted for cutting a work piece when the drum is rotating, the cutting action of the blade causing debris created by the cutting to be ejected from the recess through the expulsion aperture (fig. 1); an airflow

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generator (7) for producing an airflow within the body for entraining and removing debris created by the cutting action of the blade; a conduit defined within the body for directing the airflow, the conduit connection to the recess by the expulsion aperture; and wherein the debris entering the conduit through the expulsion aperture travels substantially in the first direction and the airflow through the conduit adjacent to the expulsion aperture travels substantially in a second direction, and the first direction of the debris and the second direction of the airflow intersect at an acute angle ( Examiner notes the angle between the deflection flap 6, fig. 2 and the channel 5 is acute and therefore intersection of the airflow is acute).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIE or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf  
May 12, 2005

  
DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700